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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/827,558 | 04/19/2004 | Leonard S. Schultz | 6749.05 | 3428 |

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| EXAMINER |
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PATEL, SHEFALI D

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| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/827,558 | Applicant(s) SCHULTZ, LEONARD S. | |
| | Examiner Shefali D. Patel | Art Unit 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-58, 75-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-58 and 75-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment was filed on 17 February 2006.
2. Claims 79-83 are newly added.
3. Claims 1-42 and 59-74 have been cancelled.

Response to Arguments

4. Applicant's arguments with respect to claims 43-78 (Remarks on pages 7-10 filed on 30 January 2006) have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claim 43 is objected to because of the following informalities: claim 43 line 3 after the word "images" has a colon (":"). Please have this as a semicolon (";"). Appropriate correction is required.
6. Claim 43 is objected to because of the following informalities: claim 43 line 8 recites "...the stored images, associates with the new image..." This sentence does not make any sense. Perhaps the word "associates" needs to be "associating"? Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 43 line 7 recites "level of similarity." This is vague and unclear. What is the level of similarity? Is it a low level or high level? "level of similarity" as stated in the claim could be anything. This is indefinite. Appropriate correction is required.

Dependent claims 44-46 are rejected for the same reasons.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 43-45, 47, 49-51, 53-54, 75-79 and 81-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmer et al. (hereinafter, “Palmer”) (US 6,002,798).

With regard to **claim 43** Palmer discloses a device for providing a text related to an image, comprising: a microprocessor (element 10 in Figures 1 and 2); a library of stored images (the microprocessor accessing the library of images and related text thru element 34 in Figure 2 along with the storage memory 20, col. 5 lines 5-12); and a library of stored texts, wherein each of the stored texts is associated with at least one of the stored images (the library of images and related text thru element 34 in Figure 2 along with the storage memory 20, col. 5 lines 5-12; col. 5 line 62 to col. 6 lines 1-6, col. 6 lines 20-28); wherein, upon receipt of a new image, the microprocessor compares the new image to the stored images and (col. 6 lines 30-33), when a predetermined level of similarity is identified between the new image and one of the stored images (level of similarity is identified using rule-based decisions, col. 5 line 62 to col. 6 lines 1-6 and col. 6 lines 38-44), associates with the new image the stored text associated with the identified stored image (col. 6 lines 33-37).

With regard to **claim 44** Palmer discloses the new image, stored images, and stored texts digitally, col. 5 lines 5-9.

With regard to **claim 45** Palmer discloses the microprocessor using digital image recognition to determine whether there is there is the predetermined level of similarity between the new image and any of the stored images (Figure 2, element 10, 20, and 34).

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Claim 47 recites identical features as claim 43 except claim 47 is a device claim and Palmer discloses the device in Figures 1 and 2. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 47.

Claim 49 recites identical features as claim 45. Thus, arguments similar to that presented above for claim 45 is equally applicable to claim 49.

With regard to **claim 50** Palmer discloses real-time images of the new image as seen in steps S401 and S402 in Figure 4.

Claim 51 recites identical features as claim 43. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 51.

Claim 53 recites identical features as claim 44. Thus, arguments similar to that presented above for claim 44 is equally applicable to claim 53.

With regard to **claim 54** Palmer discloses means for communicating the images and texts (col. 3 lines 61-67).

Claim 75 recites identical features as claim 43. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 75.

Claims 76 and 77 recites identical features as claim 44. Thus, arguments similar to that presented above for claim 44 is equally applicable to claims 76 and 77.

With regard to **claim 78** Palmer discloses selecting an image and the library of text by using a microprocessor as seen in Figure 2 at elements 34 and 10 (CPU 11).

Claim 79 recites identical features as claim 45. Thus, arguments similar to that presented above for claim 45 is equally applicable to claim 79.

Claim 81 recites identical features as claim 43. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 81.

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Claim 82 recites identical features as claim 44. Thus, arguments similar to that presented above for claim 44 is equally applicable to claim 82.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 46, 48, 55, 56-58, 80 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer in view of Prokoski (US 6,529,617).

With regard to **claim 56** Palmer discloses all of the features as disclosed above in claim 43 and the arguments are not repeated herein, but are incorporated by reference. Palmer does not expressly disclose the records (or images and texts) being medical records. Prokoski discloses medical images and such throughout the invention, specifically as seen in Figure 14. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Prokoski with Palmer. The motivation for doing so is to use medical images specifically rather than images of documents broadly as used in Palmer. The documents in Palmer can be any medical image that can be scanned into the system to have available both image and the related texts. Therefore, it would have been obvious to combine Prokoski with Palmer to obtain the invention as specified in claim 56.

With regard to **claim 57** Prokoski captures, processes and creates plurality of images as seen in Figure 14.

With regard to **claim 58** Prokoski discloses the library digital images signals and text descriptions comprising an electronically accessible database as seen in Figure 18 and its respective portions in the specification.

With regard to **claim 46** Prokoski discloses when no predetermined level of similarity between the new image and any of the stored images is identified, the microprocessor generates a signal to indicate that no match has been identified for the new image (col. 16 lines 34-47).

With regard to **claim 48** Prokoski discloses the procedure a surgical procedure and the past procedures are past surgical procedures (col. 21 lines 41-50, col. 23 lines 55-57).

With regard to **claim 55** Prokoski discloses as seen in Figure 14 the images depicts aspects of medical procedures.

Claim 80 recites identical features as claim 55. Thus, arguments similar to that presented above for claim 55 is equally applicable to claim 80.

Claim 83 recites identical features as claim 46. Thus, arguments similar to that presented above for claim 46 is equally applicable to claim 83.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

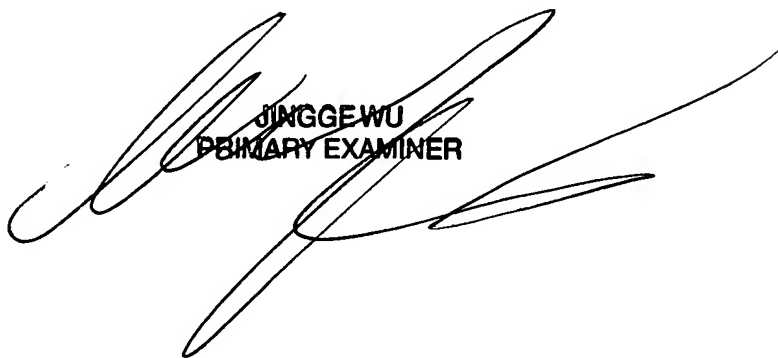
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel
Examiner
Art Unit 2624

April 21, 2006


JINGGEWU
PRIMARY EXAMINER